UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,311	08/20/2001	Douglas S. Makofka	GIC-626	7059

20028 7590 08/15/2005

Lipsitz & McAllister, LLC
755 MAIN STREET
MONROE, CT 06468

EXAMINER	
WILDER, PETER C	
ART UNIT	**PAPER NUMBER**
2614	

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/933,311	MAKOFKA, DOUGLAS S.	
	Examiner	Art Unit	
	Peter C. Wilder	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-34 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-34 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3,13,16-20,30,33,34 rejected under 35 U.S.C. 102(e) as being inherent by Plotnick et al. (provisional application April 3, 2001) (All further references to Plotnick et al. are to the April 3, 2001 provisional application).

1. Regarding claim 1 Plotnick et al. teaches a method for the display of advertising material during personal versatile recorder (PVR) trick play modes (page 8, last row of table 2),

comprising the steps of: storing program material on a PVR (page 6, table 1 last column talks about TiVo systems which are a type of PVR that can store programs);

storing advertising material on a PVR (page 1, last paragraph);

and merging the advertising material with the program material during PVR trick play modes such that the advertising material is displayed during said trick play modes(page 8 last row of table 2).

2. Regarding claim 2, Plotnick et a. teaches wherein the trick play modes comprise at least one of pause, scan forward, scan backward, jump, and still frame display (page 1, last paragraph).

3. Regarding claim 3, Plotnick et al. teaches a method wherein the advertising material to be displayed is controlled by an ad selection engine (pages 17-18, part D). Behavioral Targeting using Structured Ad Queues and placing the ads in the queue to be inserted into programs based on demographics, shared product features, and other likelihoods. This queuing of advertisements is a form of an advertisement selection engine.

4. Regarding claim 13, Plotnick et al. teaches a method wherein the advertising material is provided by at least one of an RF cable network, a DSL network, a DOCSIS network, a dial-up network, a wireless network, and a satellite network (page 3 in Figure 1 it references a satellite can be used to receive the signal by the tuner block).

5. Regarding claim 16, Plotnick et al. teaches a method, wherein the advertising material is based on customer preference (page 9, table 5, first row, last column).

6. Regarding claim 17, Plotnick et al. teaches wherein the PVR comprises one of a set-top terminal, a digital television, or a personal computer (page 3, 2nd paragraph).

7. Regarding claim 18, Plotnick et al. also teaches a personal versatile recorder (PVR) apparatus for the display of advertising material during trick play modes (page 8, last row of table 2),

comprising: one or more memory devices for storing program material and advertising material on the PVR (page 1 and page 3 figure 1 "Disk Drive");

a display engine associated with the one or more memory devices for providing display output (page 3 figure 1 describes a display engine "Television");

and an motion control engine for directing the display engine to merge the advertising material with the program material during PVR trick play modes such that the advertising material is displayed during said trick play modes (page 3, figure 1, the motion control engine is the Remote control demodulator that receives the trick play commands coupled with the processor.)

8. Regarding claim 19, Plotnick et al. teaches an apparatus wherein the trick play modes comprise at least one of pause, scan forward, scan backward, jump, and still frame display (page 1, last paragraph).

9. Regarding claim 20, Plotnick et al. teaches an apparatus in accordance with claim 18, further comprising: an ad selection engine for controlling the advertising material to be displayed. (pages 17-18, part D) (Behavioral Targeting using Structured Ad Queues and placing the ads in the queue to be inserted into programs based on demographics, shared product features, and other likelihoods. This queuing of advertisements is a form of an advertisement selection engine.)

10. Regarding claim 30, Plotnick et al. teaches an apparatus in accordance with claim 18, further comprising a network connection to at least one of an RF cable network, a DSL network, a DOCSIS network, a dial-up network, a wireless network, and a satellite network for providing the advertising material (page 3 figure 1, it references a satellite can be used to receive the signal by the tuner block).

11. Regarding claim 33, Plotnick et al. teaches an apparatus in accordance with claim 18, wherein the advertising material is based on customer preference (page 9, table 5, first row, last column).

12. Regarding claim 34, Plotnick et al. teaches an apparatus in accordance with claim 18, wherein the PVR comprises one of a set-top terminal, a digital television, or a personal computer (page 3, 2nd paragraph).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 4 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. in view of Sextro et al. (U.S. 2002/0040482 A1).

Referring to claim 4, Plotnick et al. teaches all the limitations in claim 1 as well as the concept of displaying advertisements on a screen during trick play modes (page 8, last row of table 2), but fails to teach that alpha blending is used to display the advertisements on the screen.

Sextro teaches on page 3 ¶ [0028] (which starts on page 2) that alpha blending can be used to display internet data on the screen.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the advertisement display function/device of Plotnicket al., using the alpha blending function/devices of Sextro for the purpose of not wanting to fully obscure the underlying data (Pages 2-3, ¶ [0028]).

14. Referring to claim 21, see the rejection of claim 4.

15. Claims 5 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. in view of Gordon et al. (U.S. 6481012 B1).

Referring to claim 5, Plotnick et al. teaches all the limitations in claim 1 as well as the concept of displaying advertisements on a screen during trick play modes (page 8, last row of table 2), but fails to teach the idea of displaying the advertisement in a picture-in-picture format on the screen.

Gordon et al. teaches on that picture-in-picture can be used in televisions and can display an advertisement (Column 19 lines 63-67 and Column 20 lines 1 – 7 for picture-in-picture, Column 7 lines 15-16 for television reference).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the advertisement display function/device of Plotnick et al., using the picture-in-picture function/devices of Gordon for purpose of opening up a world of possible applications in the areas of interactive shopping, internet-enhanced television and other real-time information services (Column 2 lines 20-23).

16. Referring to claim 22, see the rejection of claim 5.

17. Claims 6, 15, 23, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. in view of Zustak et al. (U.S. 2002/0087402 A1).

Referring to claim 6, Plotnick et al. teaches all the limitations in claim 1 as well as the concept of displaying advertisements on a screen during trick play modes (page 8, last row of table 2), but fails to teach the idea of displaying the advertisement in banner or border format on the screen.

Zustak teaches on page 5 ¶ [0050] that an advertisement can be display in a banner format on the screen.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the advertisement display function/device of Plotnick et al., using the banner format function/devices of Zustak for the purpose of using a banner advertisement because it would not be as intrusive to the viewer (Page 5, ¶ [0050]).

18. Referring to claim 23, see the rejection of claim 6.

19. Referring to claim 15, Plotnick et al. teaches all the limitations in claim 14 as well as the concept of displaying advertisements on a screen during trick play modes (page 8, last row of table 2), but fails to teach the idea of being able to download the advertisement from the source when the program material is accessed.

Zustak on page 7 ¶ [0065] and in figure 9 elements 934 and 938 occur simultaneously, thus showing the concept of downloading the advertisements while the program material is being accessed.

At the time the invention was made, it would have been obvious for a person of ordinary skill in the art, to modify the advertisement display function/device of Plotnick et al. by using the dual access and download function/devices of Zustak for the purpose of allowing the parallel processing of data along with the displaying of the entertainment thus the system is being more productive.

20. Referring to claim 32, see the rejection of claim 15.

21. Claims 7, 14, 24, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. in view of Chang et al. (U.S. 2002/0129362 A1).

Referring to claim 7, Plotnick et al. teaches all the limitations in claim 1 as well as the concept of displaying advertisements on a screen during trick play modes (page 8, last row of table 2), but fails to teach the idea of being able to partially see a program during a trick play mode.

Chang et al. teaches on page 6 ¶ [0058] the idea of displaying a second commercial over the main commercial using picture-in-picture. As can be seen in figure 6, element 602 is the regular commercial which is still visible while element 604 is another commercial being displayed over it.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the advertisement display function/device of Plotnick et al., using the partially visible commercial

function/devices of Chang et al. for the purpose of allowing an end user to select amoung a number of candidate commercials that may be shown (page 1 ¶ [0009]).

22. Referring to claim 24, see the rejection of claim 7.

23. Referring to claim 14, Plotnick et al. teaches all the limitations in claim 1 as well as the concept of displaying advertisements on a screen during trick play modes (page 8, last row of table 2), but fails to teach the idea of providing information regarding a source of the advertising material, and also being able to download the advertisement from the source.

Chang teaches that commercials or advertisements can be downloaded from a remote server to a set-top-box from a remote server. The set-top-box then knows the source of the advertisement data if it is being downloaded from a media serve which it is connected to (page 6 ¶ [0055]). (Figure 1 element 22 is connected to element 12 by way of element 20; On page 6 ¶ [0055] Chang mentions downloading advertisements to a set-top-box which is the same thing as a PVR.)

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the advertisement display function/device of Plotnicket al., using the server downloading function/devices of

Chnag for the purpose of enable the head end to charge advertisers in accordance with the frequency of commercials viewed (Pages 6, ¶ [0055]).

24. Referring to claim 31, see the rejection of claim 14.

25. Claims 8 and 25 are rejected under 35 U.S.C 103(a) as being unpatentable over Plotnick et al.

Referring to claim 8 Plotnick et al. teaches all the limitations in claim 1, but fails to teach the concept of displaying an advertisement that is unrelated to the program being displayed.

The examiner takes Official Notice that it is well known for that an advertisement displayed on a screen may not be related to the program. For example during a football game a battery commercial is displayed. A battery has no relationship to a football game so this is a common example of an advertisement not being related to the program.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify claim 8, as taught by Plotnick, using the teaching of displaying an unrelated advertisement during a program being viewed, for the purpose of providing independent manufactures the need to advertise their product, so the manufactures display the advertisements during programs that will benefit them the most (example: a Super Bowl which would have a lot of viewers).

26. Referring to claim 25, see the rejection of claim 8.

27. Claims 9, 10, 11, 26, 27, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. in view of Thomas et al. (U.S. 2003/0037068 A1).

Referring to claim 9, Plotnick et al. teaches all the limitations in claim 1 as well as the concept of displaying advertisements on a screen during trick play modes (page 8, last row of table 2), but fails to teach the idea of relating the advertisement displayed on the screen to the program material.

Thomas teaches on page 4 ¶ [0043] displaying a related advertisement during a pause in the programming. The example they use is displaying an advertisement for golf related equipment while a golf tournament is paused.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the advertisement display function/device of Plotnick et al., using the related advertisement function/devices of Thomas for the purpose of providing an improved interactive media application (page 1 ¶ [0007).

28. Referring to claim 26, see the rejection of claim 9.

29. Referring to claim 10, Plotnick et al. teaches all the limitations in claim 9 as well as the concept of displaying advertisements on a screen during trick play modes (page 8, last row of table 2), but fails to teach the idea of relating the advertisement displayed on the screen to the program material.

Thomas teaches on page 4 ¶ [0043] displaying a related advertisement during a pause in the programming, but fails to explicitly teach the idea of storing the advertising material only while the associated program is displayed.

The examiner take Official Notice that it is well known that at there would be no need to keep an advertisement related to a specific program once the program is done being displayed. For example in Thomas et al. teaches on page 4 ¶ [0044] about relating an advertisement during pause time content to the program being displayed. Thomas et al. references an actor could be wearing brand name clothes, and then an advertisement during the next trick play could be an advertisement from the brand of clothes the actor was wearing.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the advertisement display device during trick plays as taught by Plotnick, using the idea of deleting the advertisement when the program is done being displayed as taught by Thomas, for the purpose of once the program is done showing the related advertisement should be deleted to conserve disc space.

30. Referring to claim 27, see the rejection of claim 10.

31. Referring to claim 11, Plotnick et al. teaches all the limitations in claim 9 as well as the concept of displaying advertisements on a screen during trick play modes (page 8, last row of table 2), but fails to teach the idea of relating the advertisement to the current program.

Thomas teaches on page 4 ¶ [0043] displaying a related advertisement during a pause in the programming, but fails to explicitly teach the idea of storing the advertising material as long as the program material is stored.

The examiner take Official Notice that it is well known that a program and related advertisement are downloaded together then it would make sense to delete the related advertisement when the program is deleted. For example in Thomas et al. teaches on page 4 ¶ [0044] about relating an advertisement during pause time content to the program being displayed. Thomas et al. references an actor could be wearing brand name clothes, and then an advertisement during the next trick play could be an advertisement from the brand of clothes the actor was wearing.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the advertisement display device during trick plays as taught by Plotnick, using the concept of deleting the advertisement when the related show is deleted as taught by Thomas, for the purpose of once user decides to delete the program the related advertisement should be deleted to conserve disc space.

32. Referring to claim 28, see the rejection of claim 11.

33. Claims 12 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. in view of Fudge et al. (U.S. 2003/0016302 A1).

Referring to claim 12, Plotnick et al. teaches all the limitations in claim 1 as well as the concept of displaying advertisements on a screen during trick play modes (page 8, last row of table 2), but fails to teach the idea of storing the advertisements separately from the programs.

Fudge et al. teaches on page 5-6 ¶ [0061] the storing of advertisements or different types of data on a separate removable hard drives from other types of data.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the advertisement display function/device of Plotnick et al., using the storage function/devices of Fudge et al. in terms of storing the advertisements separately from the program for the purpose that this will allow for fast accessing of data (page 5-6 ¶ [0061]).

34. Referring to claim 29, see the rejection of claim 12.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter C. Wilder whose telephone number is 571-272-2826. The examiner can normally be reached on 8 AM - 4PM Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***

Jason Salce
8-11-05